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21 ALPHA & OMEGA SEMICONDUCTOR, INC.
22 ALPHA & OMEGA SEMICONDUCTOR, LTD.

23 UNITED STATES DISTRICT COURT
24 NORTHERN DISTRICT OF CALIFORNIA
25 SAN FRANCISCO DIVISION

26 ALPHA & OMEGA SEMICONDUCTOR,
27 INC., a California corporation; and
28 ALPHA & OMEGA SEMICONDUCTOR,
LTD., a Bermuda corporation,

Plaintiffs,

v.

FAIRCHILD SEMICONDUCTOR
CORP., a Delaware corporation,

Defendant.

AND RELATED COUNTERCLAIMS

Case No. C 07-2638 JSW

**ALPHA & OMEGA SEMICONDUCTOR,
LTD.'S REPLY AND AFFIRMATIVE
DEFENSES TO FAIRCHILD'S
COUNTERCLAIMS**

DEMAND FOR JURY TRIAL

Alpha & Omega Semiconductor, Ltd. (“AOS, Ltd.”) responds to the counterclaims of Fairchild Semiconductor Corp. (“Fairchild”) as follows:

JURISDICTION AND VENUE

1. AOS, Ltd. denies that it has infringed or now infringes the patents asserted against AOS, Ltd. in Fairchild’s counterclaims. AOS, Ltd. admits, without admitting the validity of Fairchild’s patent infringement claims, that Fairchild’s counterclaims purport to state causes of action under the patent laws of the United States. AOS, Ltd. admits that this Court has subject matter jurisdiction over these purported claims under 28 U.S.C. §§ 1331, 1338(a), 2201 and 2202.

2. AOS, Ltd. admits, for the purpose of this action only, that venue is proper in this judicial district.

3. AOS, Ltd. admits, for the purpose of this action only, that this Court has personal jurisdiction over AOS, Ltd.

PARTIES

4. AOS, Ltd. lacks sufficient knowledge or information to admit or deny the allegations in paragraph 4.

5. AOS, Ltd. admits that Alpha & Omega Semiconductor, Inc. (“AOS, Inc.”) is a corporation duly incorporated under the laws of the State of California with its principal place of business in Sunnyvale, California. AOS, Ltd. admits that it is a Bermuda corporation and that it has a place of business in Taipei, Taiwan, but denies that its principal place of business is in Taipei, Taiwan.

FIRST COUNTERCLAIM

(Declaratory Judgment of Non-Infringement)

6. AOS, Ltd. realleges and incorporates by reference the responses stated in paragraphs 1-5 above.

7. AOS, Ltd. admits that it is the owner by assignment of U.S. Patent Numbers 5,907,776 (the “776 patent”) and 5,767,567 (the “567 patent”).

8. AOS, Ltd. admits that an actual and justiciable case or controversy exists between Fairchild on the one hand and AOS, Ltd. and AOS, Inc. on the other. AOS, Ltd. admits that it has

1 sued Fairchild alleging infringement of the '776 and '567 patents.

2 9. AOS, Ltd. denies each and every allegation contained in paragraph 9.

3 10. AOS, Ltd. admits that Fairchild purports to seek a judicial determination from this
4 Court, but AOS, Ltd. denies that there is any basis for such a determination.

5 **SECOND COUNTERCLAIM**

6 **(Declaratory Judgment of Invalidity)**

7 11. AOS, Ltd. realleges and incorporates by reference the responses stated in
8 paragraphs 1-10 above.

9 12. AOS, Ltd. admits that an actual and justiciable case or controversy exists between
10 Fairchild on the one hand and AOS, Ltd. and AOS, Inc. on the other. AOS, Ltd. admits that it has
11 sued Fairchild alleging infringement of the '776 and '567 patents.

12 13. AOS, Ltd. denies each and every allegation contained in paragraph 13.

13 14. AOS, Ltd. admits that Fairchild purports to seek a judicial determination from this
14 Court, but AOS, Ltd. denies that there is any basis for such a determination.

15 **THIRD COUNTERCLAIM**

16 **(Infringement of United States Patent No. 6,429,481)**

17 15. AOS, Ltd. realleges and incorporates by reference the responses stated in
18 paragraphs 1-5 above.

19 16. AOS, Ltd. admits that the title page of United States Patent No. 6,429,481 (the
20 “‘481 patent”) states on its face that the patent was issued on August 6, 2002. AOS, Ltd. admits
21 that on its face, the ‘481 patent is entitled “Field Effect Transistor and Method of Its
22 Manufacture.” AOS, Ltd. admits that on its face the ‘481 patent lists “Fairchild Semiconductor
23 Corporation” as its assignee. AOS, Ltd. admits that a copy of the ‘481 patent is attached to
24 Fairchild’s counterclaims as Exhibit A. AOS, Ltd. denies that the ‘481 was duly and legally
25 issued. AOS, Ltd. lacks sufficient knowledge or information to admit or deny that Fairchild
26 continues to hold all rights and interest in the ‘481 patent. AOS, Ltd. denies any and all
27 remaining allegations of paragraph 16 of Fairchild’s counterclaims.

28 17. AOS, Ltd. denies that it has been or currently is directly or indirectly infringing or

1 actively inducing or contributing to the infringement of the '481 patent. AOS, Ltd. denies any
2 and all remaining allegations of paragraph 17.

3 18. AOS, Ltd. denies each and every allegation contained in paragraph 18.

4 19. AOS, Ltd. denies each and every allegation contained in paragraph 19.

5 **FOURTH COUNTERCLAIM**

6 **(Infringement of United States Patent No. 6,710,406)**

7 20. AOS, Ltd. realleges and incorporates by reference the responses stated in
8 paragraphs 1-5 above.

9 21. AOS, Ltd. admits that the title page of United States Patent No. 6,710,406 (the
10 "'406 patent") states on its face that the patent was issued on March 23, 2004. AOS, Ltd. admits
11 that on its face, the '406 patent is entitled "Field Effect Transistor and Method of Its
12 Manufacture." AOS, Ltd. admits that on its face the '406 patent lists "Fairchild Semiconductor
13 Corporation" as its assignee. AOS, Ltd. admits that a copy of the '406 patent is attached to
14 Fairchild's counterclaims as Exhibit B. AOS, Ltd. denies that the '406 was duly and legally
15 issued. AOS, Ltd. lacks sufficient knowledge or information to admit or deny that Fairchild
16 continues to hold all rights and interest in the '406 patent. AOS, Ltd. denies any and all
17 remaining allegations of paragraph 21 of Fairchild's counterclaims.

18 22. AOS, Ltd. denies that it has been or currently is directly or indirectly infringing or
19 actively inducing or contributing to the infringement of the '406 patent. AOS, Ltd. denies any
20 and all remaining allegations of paragraph 22.

21 23. AOS, Ltd. denies each and every allegation contained in paragraph 23.

22 24. AOS, Ltd. denies each and every allegation contained in paragraph 24.

23 **FIFTH COUNTERCLAIM**

24 **(Infringement of United States Patent No. 6,521,497)**

25 25. AOS, Ltd. realleges and incorporates by reference the answers stated in paragraphs
26 1-5 above.

27 26. AOS, Ltd. admits that the title page of United States Patent No. 6,521,497 (the
28 "'497 patent") states on its face that the patent was issued on February 18, 2003. AOS, Ltd.

1 admits that on its face, the '497 patent is entitled "Method of Manufacturing a Field Effect
2 Transistor." AOS, Ltd. admits that on its face the '497 patent lists "Fairchild Semiconductor
3 Corporation" as its assignee. AOS, Ltd. admits that a copy of the '497 patent is attached to
4 Fairchild's counterclaims as Exhibit C. AOS, Ltd. denies that the '497 was duly and legally
5 issued. AOS, Ltd. lacks sufficient knowledge or information to admit or deny that Fairchild
6 continues to hold all rights and interest in the '497 patent. AOS, Ltd. denies any and all
7 remaining allegations of paragraph 26 of Fairchild's counterclaims.

8 27. AOS, Ltd. denies that it has been or currently is directly or indirectly infringing or
9 actively inducing or contributing to the infringement of the '497 patent. AOS, Ltd. denies any
10 and all remaining allegations of paragraph 27.

11 28. AOS, Ltd. denies each and every allegation contained in paragraph 28.

12 29. AOS, Ltd. denies each and every allegation contained in paragraph 29.

13 **SIXTH COUNTERCLAIM**

14 **(Infringement of United States Patent No. 6,828,195)**

15 30. AOS, Ltd. realleges and incorporates by reference the answers stated in paragraphs
16 1-5 above.

17 31. AOS, Ltd. admits that the title page of United States Patent No. 6,828,195 (the
18 "'195 patent'") states on its face that the patent was issued on December 7, 2004. AOS, Ltd.
19 admits that on its face, the '195 patent is entitled "Method of Manufacturing a Trench Transistor
20 Having a Heavy Body Region." AOS, Ltd. admits that on its face the '195 patent lists "Fairchild
21 Semiconductor Corporation" as its assignee. AOS, Ltd. admits that a copy of the '195 patent is
22 attached to Fairchild's counterclaims as Exhibit D. AOS, Ltd. denies that the '195 was duly and
23 legally issued. AOS, Ltd. lacks sufficient knowledge or information to admit or deny that
24 Fairchild continues to hold all rights and interest in the '195 patent. AOS, Ltd. denies any and all
25 remaining allegations of paragraph 31 of Fairchild's counterclaims.

26 32. AOS, Ltd. denies that it has been or currently is directly or indirectly infringing or
27 actively inducing or contributing to the infringement of the '195 patent. AOS, Ltd. denies any
28 and all remaining allegations of paragraph 32.

1 33. AOS, Ltd. denies each and every allegation contained in paragraph 33.

2 34. AOS, Ltd. denies each and every allegation contained in paragraph 34.

3 **AFFIRMATIVE AND OTHER DEFENSES**

4 Further responding to Fairchild's counterclaims, AOS, Ltd. asserts the following defenses.
5 AOS, Ltd. reserves the right to amend its response with additional defenses as further information
6 is obtained.

7 **FIRST DEFENSE**

8 **(Failure to State a Claim)**

9 35. Fairchild's counterclaims fail to state a claim against AOS, Ltd. upon which relief
10 may be granted.

11 **SECOND DEFENSE**

12 **(Non-infringement of the Asserted Patents)**

13 36. AOS, Ltd. has not infringed, contributed to the infringement of, or induced the
14 infringement of any valid claim of the '481, '406, '497, or '195 patents, and is not liable for
15 infringement thereof.

16 37. Any and all products AOS, Ltd. makes that are accused of infringement in this
17 action have substantial uses that do not infringe and therefore cannot induce or contribute to the
18 infringement of the '481, '406, '497, or '195 patents.

19 38. No product AOS, Ltd. makes, uses, offers to sell, or imports into the United States
20 or process AOS, Ltd. uses to make AOS, Ltd.'s products infringes the '481, '406, '497, or '195
21 patents.

22 **THIRD DEFENSE**

23 **(Invalidity of the Asserted Patents)**

24 39. AOS, Ltd. believes that, after a reasonable opportunity for further investigation or
25 discovery, it will be able to demonstrate that one or more claims of the '481, '406, '497, and '195
26 patents are invalid for failing to comply with the provisions of the Patent Laws of the United
27 States, including without limitation 35 U.S.C. §§ 102, 103, and 112.

FOURTH DEFENSE

(Failure to Mark)

40. AOS, Ltd. believes that, after a reasonable opportunity for further investigation or discovery, it will be able to demonstrate that any claims for damages for alleged infringement are barred or limited due to failure to allege compliance with (and failure to comply with) the requirements of 35 U.S.C. § 287.

FIFTH DEFENSE

(Unavailability of Relief)

41. AOS, Ltd. believes that, after a reasonable opportunity for further investigation or discovery, it will be able to demonstrate that Fairchild has failed to plead and meet the requirements of 35 U.S.C. § 271(b) and (c) and is not entitled to any alleged damages prior to providing any actual notice to AOS, Ltd. of the '481, '406, '497, and/or '195 patents.

SIXTH DEFENSE

(Unavailability of Enhanced Damages)

42. AOS, Ltd. believes that, after a reasonable opportunity for further investigation or discovery, it will be able to demonstrate that Fairchild has failed to plead and meet the requirements of 35 U.S.C. § 284 for enhanced damages and is not entitled to any damages prior to providing any actual notice to AOS, Ltd. of the '481, '406, '497, and/or '195 patents.

SEVENTH DEFENSE

(Prosecution History Estoppel)

43. To the extent that Fairchild attempts to assert infringement under the doctrine of equivalents, AOS, Ltd. believes that, after a reasonable opportunity for further investigation or discovery, it will be able to demonstrate that arguments and amendments contained in the prosecution history will estop or bar any claims for alleged infringement.

EIGHTH DEFENSE

(Laches/Prosecution Laches/Estoppel)

44. AOS, Ltd. believes that, after a reasonable opportunity for further investigation or discovery, it will be able to demonstrate that any claims for alleged infringement are barred or

1 limited by the doctrine of laches, prosecution laches, and/or equitable estoppel.

2 **NINTH DEFENSE**

3 **(Adequate Remedy At Law)**

4 45. AOS, Ltd. believes that, after a reasonable opportunity for further investigation or
5 discovery, it will be able to demonstrate that any claims for injunctive relief are barred in light of
6 the fact that Fairchild has an adequate remedy at law.

7 **TENTH DEFENSE**

8 **(Res Judicata / Collateral Estoppel)**

9 46. Fairchild's counterclaims alleging infringement of the '481, '406, '497, and '195
10 patents are barred because of the doctrines of res judicata and collateral estoppel.

11 **PRAYER FOR RELIEF**

12 WHEREFORE, AOS, Ltd. prays for the entry of judgment as follows:

13 A. Dismissing with prejudice any and all of Fairchild's counterclaims and ordering
14 that Fairchild take nothing as a result;

15 B. Awarding AOS, Ltd. its reasonable attorneys' fees, expenses and costs incurred in
16 this action;

17 C. Granting AOS, Ltd. such other action and further relief as this Court may deem
18 just and proper, or that AOS, Ltd. may be entitled to as a matter of law or equity.

19 Dated: July 9, 2007

MORGAN, LEWIS & BOCKIUS LLP

21 By /s/ Daniel Johnson, Jr.

22 Daniel Johnson, Jr.
23 Attorneys for Plaintiffs and Counterdefendants
24 ALPHA & OMEGA SEMICONDUCTOR,
25 LTD., AND ALPHA & OMEGA
26 SEMICONDUCTOR, INC.

DEMAND FOR JURY TRIAL

AOS, Ltd. hereby requests a trial by jury.

Dated: July 9, 2007

MORGAN, LEWIS & BOCKIUS LLP

By /s/ Daniel Johnson, Jr.

Daniel Johnson, Jr.
Attorneys for Plaintiffs and Counterdefendants
ALPHA & OMEGA SEMICONDUCTOR,
LTD., AND ALPHA & OMEGA
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